
Application No.: 09/771054Case No.: 56147US002

REMARKS

Reexamination and reconsideration of the application are respectfully requested.

The Applicant's objects to the application of finality in the recent Office Action. The prior art reference Chang was one, which clearly was of record in the present application in that it was used to previously reject the composition claims initially presented. The compositional scope of the previously presented claims was not changed in a manner which necessitated this renew grounds for rejection based on Chang. If Change was of concern, which it should not be, it clearly should have been applied to the claims in the first office action. The only change in the claimed subject matter was to the minor variations of the uses to which the application method claims are directed to address the claim rejections under 35 U.S.C. 101 and 112. In that Chang was clearly of record and had been previously applied the application of a final rejection to the previously presented claims reintroducing Chang as a prior art rejection is clearly inappropriate and requested withdrawn.

The rejection over Chang is also inappropriate in that Applicant's are not claiming a new use, function or property for a composition as per the in re Best case cited or the referred to MPEP sections 112.01 and 2141.02. In re Best is use in MPEP Section 2112.01 purely is relation to compositional product and apparatus claims not to method of using claims, which the present application is directed. Applicants' are not trying to reclaim a known composition. Rather what is claimed is an entirely new method of using what is alleged to be a known composition disclosed in Chang. In MPEP section 2141.02 the Examiner should be paying attention to is the section entitled DISTILLING THE INVENTION DOWN TO A "GIST" OR "THRUST" OF AN INVENTION DISREGARDS "AS A WHOLE" REQUIREMENT. The Examiner is re-characterizing the method claims to be merely a method to coat surfaces which is taught in which is allegedly the same as re-characterized teaching of Chang. However applicants are not claiming a method to generically coat "surfaces" and the teachings of Chang not to use their composition to generically coat surfaces. The object of Chang is to permanently modify the surface of a porous coating by penetrating the porous coating with it's composition and then

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to initiate cure while it is penetrated to create a durable permanent coating. Clearly looking at this actual teaching in Chang one of skill in the art would not be motivated to a method of using Changs compositions as a cosmetic article to treat a person's skin or nails. A permanent coating of the type taught in Chang for treatment of a porous substrate, such as leather, would be antithetical to the requirements of human use. Chang would actually teach away from the claimed method of using not towards it. The key is looking at the specific teachings of Chang versus what is specifically claimed and not re-characterizing the method of Chang as the claimed method as both generic methods of coating some generic surfaces.

Similarly the secondary reference Gaa adds nothing to the Chang reference. Gaa again is related to a coating which intend to be permanent, rather in this case it is made permanent by composition reacting with the surface it is coating. Again something that would be undesirable and inapplicable to treatment of a person's skin or nails.

Applicants have attached a recent decision of the PTO Board with similar facts, Ex parte Abbas, appeal number 2005-0944. In this case the claims where directed at novel method of using a child's toy , namely a method to mask a hunters scent while hunting. The toy was a propellant foam, so the only real difference was aiming the foam at a pray animal rather than another kid or the like. The art clearly did not teach this use, which like here could have been re-characterized as spraying the foam at an object.

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Nevertheless, we find no motivation, suggestion, or teaching in either Cox or Konietzki to make the examiner's proposed combination. While Cox suggests a method for applying the foam on "inert surfaces such as windows, walls, and the like" for play purposes (column 2, lines 63-68), such a purpose has no relation to hunting. Nothing in the applied prior art references would have led one of ordinary skill in the art to modify Cox's play method into a method for distributing [in a hunting ground] a scented chemical composition. In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.")

I just submitted that the application claims are allowable in their present format and in any event it is specifically requested that the finality of the rejection be withdrawn as inappropriate in view of the nature of the proceedings. Applicants also respectfully request a telephone interview be conducted for the Examiner and the Supervisor of the Application Mr. Thurman Page.

Respectfully submitted,

9/30/05
Date

By:

William J. Bond, Reg. No.: 32,400
Telephone No.: 651-736-4790

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FREDERICK M. ABBAS
and
GREG ALLEN ABBAS

Appeal No. 2005-0944
Application No. 09/941,377

ON BRIEF

Before OWENS, WALTZ, and DELMENDO, Administrative Patent Judges.
DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2004) from the examiner's final rejection of claims 1 through 14 and 16 through 20 in the above-identified application. Claims 15 and 21 through 25, the only other pending claims, appear to have been allowed.¹

¹ Claims 21-25 were first submitted for examination as part of a 37 CFR § 1.116 (2004) (effective Feb. 5, 2001) amendment filed on Jun. 7, 2004. It appears that the examiner has entered

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The subject matter on appeal relates to a method for distributing a scented chemical composition for hunting animals (claims 1 and 2) and to an apparatus for distributing a scented chemical composition for hunting animals (claims 3-14 and 16-20). Further details of this appealed subject matter are recited in representative claims 1 through 3, and 9 reproduced below:

1. A method for distributing a scented chemical composition for hunting animals, the method comprising:

providing a pressurized dispenser for pressure based dispensing of a foam string from a distance away from a target, the distance being sufficient to avoid an ambient environment being contaminated by human scent, the foam string including the scented chemical composition to attract animals or mask human scent or both; and

discharging the foam string toward the target.

2. A method for a hunter to hunt animals by dispensing a chemical composition that emits a scent from a dispenser, the method comprising;

configuring a can to dispense a liquid-gas foam string of encapsulated plastic resin, the string including the chemical composition;

providing the chemical composition so as to emit the scent for a selected period of time after being dispensed, wherein the scent attracts animals or masks human scent; and

dispensing the string from the can toward a target, the string being dispensed far enough away from the can that the hunter does not substantially

this amendment. (Examiner's answer mailed on Jul. 20, 2004 at 2, "Grouping of Claims.")

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contaminate an area around the target.

3. An apparatus for distributing a scented chemical composition for hunting animals, the apparatus comprising:
a pressurized dispenser for pressure based dispensing; and
a foam string dispensed by the dispenser, the foam string including the scented chemical composition for hunting.

9. The apparatus of claim 3, wherein the chemical composition comprises a chemical composition that masks human scent.

The examiner relies on the following prior art references as evidence of unpatentability:

Cox et al. 3,705,669 Dec. 12, 1972
(Cox)

Easley 4,771,563 Sep. 20, 1988

Konietzki 4,788,787 Dec. 6, 1988

Claims 1 through 6, 11 through 14, and 16 through 20 on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Cox in view of Konietzki. (Answer at 3-4.)

Correspondingly, dependent claims 7 through 10 on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Cox in view of Konietzki, as applied to claim 1, and further in view of Easley. (Id. at 4.)

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We reverse as to claims 1 and 2 but affirm as to claims 3 through 14 and 16 through 20.²

Cox, the principal prior art reference, describes a pressurized dispensing container containing a composition comprising a resin for forming a cohesive body of plastic foam, a surfactant for providing a surface of controlled tackiness on the foam, and a propellant in which the resin and the surfactant are soluble for propelling the composition from the container and for subsequent expansion to form the foam. (Column 1, lines 19-27.) Cox further teaches that "[a]s the composition is expelled, it remains in the form of a thin string..." (Column 2, lines 48-53.) Cox also teaches that "if desired perfumes."^[3]

² With respect to the rejection based on Cox and Konietzki, the appellants state that the claims should be considered separately in two groups as follows: (I) claims 1, 2, and 11; and (II) claims 3-6, 12-14, and 16-20. (Appeal brief filed on Jun. 7, 2004 at 4.) For reasons discussed more fully below, we will consider claims 1, 2, and 11 individually. As to Group II, we select claim 3 as representative and confine our discussion to this representative claim. 37 CFR § 1.192(c)(7)(2003) (effective Apr. 21, 1995). With respect to the rejection based on Cox, Konietzki, and Easley, the appellants state that claims 7-10 stand or fall together. (Appeal brief at 4.) We select claim 9 as representative and confine our discussion to this representative claim.

^[3] With respect to the definition of the term "perfume," Merriam-Webster's Collegiate Dictionary 863 (10th ed., 1996), copy attached, includes the following: "a substance that emits a pleasant odor; esp: a fluid preparation of natural essences (as

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~~or other odors may be incorporated in the composition."~~ Column 7, lines 12-14.) According to Cox, the container may be used as a toy or play article. (Column 1, lines 7-15.) Nothing in Cox suggests the use of the disclosed container for hunting animals;

Konietzki, the other reference on which the examiner relies to reject appealed claims 1 and 2, discloses a scent propagation device having a leak-proof container and a line contained in a housing that is saturated with liquid concentrate of a scent indigenous to the environment of the game that is hunted.

(Column 1, lines 51-55.) According to Konietzki, the line may be drawn out from within the housing as a means of dispersing the scent. (Column 1, lines 55-57.)

The examiner states that "Cox et al. do not disclose a scent for a hunter to lure animals" but that one of ordinary skill in the art would have been led to combine the teachings of Cox and Konietzki to arrive at the subject matter of appealed claims 1 and 2. (Answer at 3-4.) We disagree.

As a preliminary matter, we note that appealed claim 1 recites "scented chemical composition to attract animals or mask human scent." (Emphasis added.) Thus, contrary to the

from plants or animals) or synthetics and a fixative used for scenting."

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examiner's finding, Cox discloses the use of a "scented chemical composition" in the form of perfumes. Similarly, appealed claim 2 recites "scented chemical composition for hunting." The subject specification informs one skilled in the relevant art that the term "chemical composition" includes "a composition that masks human scent." (Specification at 3.) Accordingly, one skilled in the relevant art would understand that the recitation "scented chemical composition for hunting" encompasses Cox's perfumes, which would serve to mask human scent.

Nevertheless, we find no motivation, suggestion, or teaching in either Cox or Konietzki to make the examiner's proposed combination. While Cox suggests a method for applying the foam on "inert surfaces such as windows, walls, and the like" for play purposes (column 2, lines 63-68), such a purpose has no relation to hunting. Nothing in the applied prior art references would have led one of ordinary skill in the art to modify Cox's play method into a method for distributing [in a hunting ground] a scented chemical composition. In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("The best defense against the subtle but powerful . . .